UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/801,592 | 03/17/2004 | Marie-Christine Seguin | BONN-101-A | 4175 |

32954 7590 01/25/2007

JAMES C. LYDON
100 DAINGERFIELD ROAD
SUITE 100
ALEXANDRIA, VA 22314

| EXAMINER | |
|---|---|
| WINSTON, RANDALL O | |
| ART UNIT | PAPER NUMBER |
| 1655 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 01/25/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/801,592 | SEGUIN, MARIE-CHRISTINE | |
| | Examiner | Art Unit | |
| | Randall Winston | 1655 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 November 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *20-37* is/are pending in the application.

4a) Of the above claim(s) *20-31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *20 and 32-37* is/are rejected.

7)☒ Claim(s) *32-37* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. 10/404,058.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *0106,0304*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election with traverse of Group II, claims 32-37 in its response to the restriction requirement of 11/09/2006 is acknowledged. The traversal is based on the grounds that the Restriction Requirement should be withdrawn because examination of the entire application can be made without serious burden. MPEP 803 requires examination of claims to admittedly independent or distinct inventions where, as here, search and examination of the entire application can be made without serious burden to the Examiner.

Applicant's argument is not found persuasive because, as Examiner explained in the previous restriction requirement of 10/10/2006, Inventions I and II are related as product (i.e. I) and process of use (i.e. II). The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). In the instant case, the product as claimed (i.e. citrullinylarginine dipeptide) can be used in a materially different process of using that product such as for various treatments of different types of cosmetic disorders (see, e.g. Seguin (US 6716436), entire patent, especially the title and abstract). Therefore, the several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as separate subject for inventive effect and require independent searches. The search for each of the above inventions is not co-extensive particularly

with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all the above inventions in one application.

The restriction requirement is still deemed proper and is therefore made final.

Claims 20-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Claims 32-37 and dependent claim 20 will be examined on the merits.

***Claim Objections***

Claims 32-37 are objected to because they are dependent on non-elected claims. Therefore, a 35 U.S.C. 112, second paragraph, would be need if non-elected claims are not cancelled. (please note that claims 32-37 and 20 will be examined on the merits because claim 20 depends on claim 32)

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20 and 32-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent 6,716,436. Although the conflicting claims are not identical, they are not patentably distinct from each other because in both cases, the claims are drawn to a method of administering to said mammal a composition comprising an extraction of an algae (i.e. red algae) to produce a cosmetic composition comprising an analog of citrullinyularginine natural dipeptide (i.e. the analog of citrullinyularginine natural dipeptide is L-citrullinyl-L-arginine) and including an acceptable carrier within the composition. Further, the instantly claimed invention encompasses the claimed invention of 6,716,436.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20 and 32-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 20 and 32-37 are rendered exceedingly vague and indefinite for reasons too numerous to individually mention. Below are other examples of vague and indefinite terms and phrases.

Claim 20 recites the phrase "with the help of a pharmaceutically acceptable solvent or solvent mixture". No objective criterion is provided in the specification or claim to apprise one of skill in the art of the meaning of "with the help of a pharmaceutically acceptable solvent or solvent mixture". There is no definition of "with the help of a pharmaceutically acceptable solvent or solvent mixture" in the claims or specification to apprise one of skill in the art with an unambiguous meaning of the claimed invention. It is unclear to examiner of what does "with the help of a pharmaceutically acceptable solvent or solvent mixture" mean? Therefore, applicant may overcome this rejection by clearly delineating the metes and bounds of what is "with the help of a pharmaceutically acceptable solvent or solvent mixture"? (Is applicant extracting an algae with a solvent to produce a citrullinylarginine natural dipeptide?)

Claim 20 recites the phrase "enhancement of the weight amount of". No objective criterion is provided in the specification or claim to apprise one of skill in the art of the meaning of "enhancement of the weight amount of". There is no definition of "enhancement of the weight amount of" in the claims or specification to apprise one of skill in the art with an unambiguous meaning of the claimed invention. It is unclear to examiner of what does "enhancement of the weight amount of" mean? Therefore, applicant may overcome this rejection by clearly delineating the metes and bounds of what is "enhancement of the weight amount of"? (How does this enhancement step relate to the extraction of algae?, and What is applicant enhancing? Is applicant enhancing the algae?)

Claim 20 recites the term "heat treatment". No objective criterion is provided in the specification or claim to apprise one of skill in the art of the meaning of "heat treatment". There is no definition of "heat treatment" in the claims or specification to apprise one of skill in the art with an unambiguous meaning of the claimed invention. It is unclear to examiner of what does "heat treatment " mean? Therefore, applicant may overcome this rejection by clearly delineating the metes and bounds of what is "heat treatment"? (How does this heat treatment step relate to the extraction of algae?, and Why is applicant heat treating the resulting seaweed extract? )

Claim 20 recites the phrase "resulting seaweed extract". No objective criterion is provided in the specification or claim to apprise one of skill in the art of the meaning of "resulting seaweed extract". There is no definition of "resulting seaweed extract" in the claims or specification to apprise one of skill in the art with an unambiguous meaning of the claimed invention. It is unclear to examiner of what does "resulting seaweed extract " mean? Therefore, applicant may overcome this rejection by clearly delineating the metes and bounds of what is "resulting seaweed extract"? (How does resulting seaweed extract relate to extracting the algae to produce the desired compound and/or composition?)

Claim 20 recites the phrase "adding said extract". No objective criterion is provided in the specification or claim to apprise one of skill in the art of the meaning of "adding said extract". There is no definition of "adding said extract" in the claims or specification to apprise one of skill in the art with an unambiguous meaning of the claimed invention. It is unclear to examiner of what does "adding said extract " mean?

Therefore, applicant may overcome this rejection by clearly delineating the metes and bounds of what is "adding said extract"? (How is applicant adding said extract to a carrier? And Why is applicant adding said extract to a carrier?)

Claims 36-37 recite the term " a care agent". No objective criterion is provided in the specification or claim to apprise one of skill in the art of the meaning of "a care agent". There is no definition of "a care agent" in the claims or specification to apprise one of skill in the art with an unambiguous meaning of the claimed invention. It is unclear to examiner of what does "a car agent" mean? Therefore, applicant may overcome this rejection by clearly delineating the metes and bounds of what is "a care agent?)

All other claims depend directly or indirectly from rejected claims and are, therefore, also rejected under 35 U.S.C. 112, second paragraph for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Winston whose telephone number is 571-272-0972. The examiner can normally be reached on 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SUSAN COE HOFFMAN
PRIMARY EXAMINER